

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/862,577
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Inventorship William R. Hartigan
Group Art Unit..... 3626
Examiner FRENEL, Vanel
Confirmation No. 7975
Attorney's Docket No. 008.001.USP
Title: Method And System For Providing Online Insurance Information

APPEAL BRIEF

To: MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

As required under 37 C.F.R. §41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on August 1, 2007, and is in furtherance to the Notice of Appeal.

This brief contains items under the following headings as required by 37 C.F.R. §41.37 and M.P.E.P. §1206:

- I. Real Party In Interest
- II. Related Appeals, Interferences, and Judicial Proceedings
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims Appendix
- IX. Evidence Appendix
- X. Related Proceedings Appendix

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is the sole inventor William R. Hartigan.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 20 claims pending in this application (Claims 1-4, 6-9, and 11-22).

B. Current Status of Claims

1. Claims canceled: 5 and 10
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 1-4, 6-9, and 11-22
4. Claims allowed: none
5. Claims rejected: 1-4, 6-9, and 11-22

C. Claims on Appeal

The claims on appeal are claims 1-4, 6-9, and 11-22.

IV. STATUS OF AMENDMENTS

Appellant last amended the claims in an Amendment and Response filed on May 26, 2006. A Response was also filed on February 19, 2007, but no further amendments were made. Therefore the claims on appeal (as reflected in the claim appendix) are the claims presented in the Amendment and Response filed on May 26, 2006 and have already been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

According to claim 1, a computer-implemented method for providing insurance information across a network (130 in FIG. 1; p. 12, l. 31 to p. 14, l. 3). The method comprising receiving an access code (2202 in FIG. 22; p. 18, ll. 1-7) from a user (140 in FIG. 1; p. 12, l. 31 to p. 14, l. 3) via the network (130 in FIG. 1). Receiving a password (2204 in FIG. 22; p. 18, ll. 1-7) from a user (140 in FIG. 1) via the network (130 in FIG. 1). Executing computer-implemented instructions for determining a user class (p. 10, ll. 17-24) of the user (140 in FIG. 1) from the access code (2202 in FIG. 22) and password (2204 in FIG. 22), the user class (p. 10, ll. 17-24) being one of an agent (p. 10, l. 29 to p. 11, l. 12) or a certificate holder (p. 11, ll. 13-21). In the event that the user is an agent (p. 10, l. 29 to p. 11, l. 12), permitting the agent (p. 10, l. 29 to p. 11, l. 12) to enter insurance information (p. 10, ll.10-16; p. 13, ll. 7-27) including a certificate of insurance (FIG. 6-6C and FIG. 53; p. 32, l. 18- p. 33, l. 29; also p. 1, l. 14 to p. 3, l. 19) for an insured (p. 10, l. 8-9); storing the insurance information (p. 10, ll.10-16; p. 13, ll. 7-27) along with the date and time of entry as a record in a database (120 in FIG. 1; p. 10, ll.10-16; p. 13, ll. 7-27); and executing computer-implemented instructions for generating an access code and password corresponding to the insured. In the event that the user is a certificate holder (p. 11, ll. 13-21), permitting the certificate holder (p. 11, ll. 13-21) to view insurance information (p. 10, ll.10-16; p. 13, ll. 7-27) for the insured corresponding to the insured's access code and password; receiving a set of insurance requirements (FIG. 5-5A and FIG. 45-51; p. 11, l. 27 to p. 12,

I. 4; p. 27, I. 14 to p. 30, I. 2) from the certificate holder (p. 11, II. 13-21) via the network (130 in FIG. 1); executing computer-implemented instructions for comparing the set of insurance requirements (FIG. 5-5A and FIG. 45-51) from the certificate holder (p. 11, II. 13-21) to the insurance information for the insured to determine if the insurance information (p. 10, II.10-16; p. 13, II. 7-27) complies with the set of insurance requirements (FIG. 5-5A and FIG. 45-51); and executing computer-implemented instructions for displaying an exception report (FIG. 52; p. 30, I. 3 to p. 31, I. 7) to the certificate holder (p. 11, II. 13-21) if the insurance information (p. 10, II.10-16; p. 13, II. 7-27) fails to comply with any of the set of insurance requirements (FIG. 5-5A and FIG. 45-51), the exception report (p. 12, II. 5-11) indicating which of the insured's insurance information (p. 10, II.10-16; p. 13, II. 7-27) violated the set of insurance requirements (FIG. 5-5A and FIG. 45-51).

According to claim 6, a computer-implemented method for retrieving and evaluating insurance information across a network (130 in FIG. 1; p. 12, I. 31 to p. 14, I. 3). The method comprising inputting at a computer (140 in FIG. 1; p. 12, I. 31 to p. 14, I. 3) in the network (130 in FIG. 1) an access code (2202 in FIG. 22; p. 18, II. 1-7) and password (2204 in FIG. 22; p. 18, II. 1-7) for at least one insured (p. 10, I. 8-9). Receiving via the network (130 in FIG. 1) at least one insurance record (p. 10, II.10-16; p. 13, II. 7-27) comprised of at least one category of insurance coverage for the at least one insured (p. 10, I. 8-9). Inputting at a computer (140 in FIG. 1) in the network (130 in FIG. 1) at least one user-specified insurance requirement (FIG. 5-5A and FIG. 45-51; p. 11, I. 27 to p. 12, I. 4; p. 27, I. 14 to p. 30, I. 2) of a certificate holder (p. 11, II. 13-21) who is not the insurance agent. Executing computer-implemented instructions for comparing the insurance record (p. 10, II.10-16; p. 13, II. 7-27) for the insured (p. 10, I. 8-9) to the user-specified insurance requirement (FIG. 5-5A and FIG. 45-51) of the certificate holder (p. 11, II. 13-21) to determine if the insurance information (p. 10, II.10-16; p. 13, II. 7-27) complies with the user-

specified requirement (FIG. 5-5A and FIG. 45-51). Displaying the results of the comparison.

According to claim 15, a system of providing proof (FIG. 6-6C and FIG. 53; p. 32, l. 18- p. 33, l. 29; also p. 1, l. 14 to p. 3, l. 19) of an insured's (p. 10, l. 8-9) insurance via a network (130 in FIG. 1; p. 12, l. 31 to p. 14, l. 3). The system comprising at least one computer-readable medium and computer-implemented instructions provided on the at least one computer-readable medium. The computer-implemented instructions for receiving insurance information (p. 10, ll.10-16; p. 13, ll. 7-27) for proof of insurance (FIG. 6-6C and FIG. 53) from an agent (p. 10, l. 29 to p. 11, l. 12) for an insured (p. 10, l. 8-9) of the agent (p. 10, l. 29 to p. 11, l. 12). Storing the insurance information (p. 10, ll.10-16; p. 13, ll. 7-27) electronically in a database (120 in FIG. 1; p. 10, ll.10-16; p. 13, ll. 7-27). Comparing the insurance information (p. 10, ll. 10-16; p. 13, ll. 7-27) to a certificate holder's (p. 11, ll. 13-21) insurance requirements (FIG. 5-5A and FIG. 45-51; p. 11, l. 27 to p. 12, l. 4; p. 27, l. 14 to p. 30, l. 2) for the insured (p. 10, l. 8-9) to determine whether the insured (p. 10, l. 8-9) complies with the certificate holder's (p. 11, ll. 13-21) insurance requirements (FIG. 5-5A and FIG. 45-51). Providing the insurance information (p. 10, ll. 10-16; p. 13, ll. 7-27) as proof of insurance (FIG. 6-6C and FIG. 53) from the database over a network (130 in FIG. 1) to the certificate holder (p. 11, ll. 13-21) who is not the agent (p. 10, l. 29 to p. 11, l. 12), the proof of insurance (FIG. 6-6C and FIG. 53) indicating whether the insured (p. 10, l. 8-9) complies with the certificate holder's (p. 11, ll. 13-21) insurance requirements (FIG. 5-5A and FIG. 45-51).

The summary is set forth in several exemplary embodiments that correspond to the independent claims. It is noted that no dependent claims containing means plus function are argued separately. Discussions about elements and recitations to these claims can be found at least at the cited locations in the specification and drawings.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Final Office Action rejected claim 1-4, 6-9, and 11-22 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0083125 to Almeida (“Almeida”) in view of U.S. Patent Application Publication No. 2002/0035488 to Aquila (hereinafter referred to as “Aquila”) in view of U.S. Patent No. 5,752,236 to Sexton, et al. (hereinafter referred to as “Sexton”). Appellant requests the Board to review each of these grounds of rejection.

VII. ARGUMENT

Rejection under 35 U.S.C. §103(a)

Claims 1-4, 6-9, and 11-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Almeida in view of Sexton.

In its recent decision, *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007), the Supreme Court reaffirmed application of the Graham factors in making a determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under Graham are: (1) determining the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary consideration. Even if all of the prior art elements are disclosed by separate prior art references, the Examiner still must identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

Independent Claim 1

Aquila was filed October 23, 2001, which is after Applicant's earliest priority date of May 19, 2000. Although Aquila claims priority to a provisional patent application filed April 3, 2000, the Examiner has not shown that the disclosure relied on to reject Applicant's claims was included in the provisional patent application. Therefore, the Examiner has failed to make a *prima facie* case which would support a rejection of Applicant's claims under 35 U.S.C. 103(a). In the event that the Examiner sustains this rejection by showing that the disclosure relied on in Aquila to reject Applicant's claims was also disclosed in Aquila's provisional patent application, Applicant expressly reserves the opportunity to show prior invention and remove Aquila as prior art. For at least the foregoing reasons Applicant believes that the rejections are moot.

In the Final Office dated May 4, 2007, the Examiner states he has satisfied the burden of presenting a *prima facie* case of obviousness, since he presented evidence of corresponding claim elements in the prior art. This statement ignores Applicant's argument that the evidence relied on by the Examiner is inadequate. The Examiner has failed to show that the corresponding claim elements are *in the prior art* (i.e., that the corresponding claim elements were in Aquila's provisional patent application and not added at a later date when the regular application was filed).

Furthermore, the examiner has consistently relied upon prior art whose purpose and function is unrelated to the purpose and function of Applicant's claims. Applicant claims relate to insurance certificates, (which function to provide proof of insurance to customers of the party covered by insurance policies), and the process of evaluating such certified insurance policies for compliance with insurance requirements. Almeida discloses an electronic system for the purpose of settling insurance claims by creating a virtual electronic community of insurers, agents, auto repair shops, window and

window replacement centers, rental car providers and providers of replacement automotive parts. Aquila also discloses administering, tracking and managing insurance claim processing systems. Sexton discloses evaluating IRS and other regulatory compliance, but not insurance coverage compliance, as claimed by the Applicant. None of these references are in any way related to certificates of insurance, as recited in the Applicant's claims and previously discussed with the Examiner by telephone following the second Office Action.

In particular, Applicant believes the Examiner confused the "digital certificate" in the primary reference, Almeida, with "certificates of insurance" and "certificate holder" recited in the claims. With reference to claim 1, for example, the Examiner relies heavily on paragraphs 0048-0057 in Almeida as disclosing various recitations including "certificates of insurance" and "certificate holder." These citations explain the use of digital signatures to authenticate the identity of parties using the Almeida system, using information such as name, location, and/or a private identification number (PIN), while the Applicant's system uses insurance policy data to create an insurance certificate as evidence of insurance for the certificate holder. The Applicant's system uses the combination User Name / Password to identify the user as either an 'agent' or 'certificate holder.'

In the Final Office dated May 4, 2007, the Examiner states that "Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references." To the contrary, Applicant has repeatedly attempted to explain the differences between the claim language and the cited references. The rejection confuses claim language which is well understood in the insurance industry and further explained in Applicant's patent application.

The “certificates of insurance” and “certificate holder” recited in Applicant’s claims are understood in the insurance industry as explained in Applicant’s “Background of the Invention” section as follows:

[0003] When one business provides a service or product to a customer, the provider must often furnish proof of insurance, especially where the service or product creates a risk of injury or damage. For example, a contractor hired to build a building typically must carry workers compensation insurance to protect his workers and liability insurance in case a third party is injured due to the contractor's negligence.

[0004] Typically, such proof is furnished in the form of a certificate of insurance, ("COI"). The service provider, contractor, tenant, borrower, vendor, or other party, who is insured by the policies shown on the COI is commonly called the "insured" and the recipient is referred to as the "certificate holder" (or more simply, "holder"). COIs are issued by an insured's insurance agent, agency broker, or by insurance companies that do not use agents or brokers (collectively referred to as an "agent"). Many holders demand a certificate for each project or location on which an insured works, thus substantially multiplying the number of certificates required for a single insured/holder relationship. Each insured may need certificates for many holders, as in the case of a plumber working for several general contractors. The agent also will normally send a copy of the certificates to the insured, a copy to each insurance company shown on the COI, and will keep a copy in the file.

Applicant believes that the distinction between “certificates of insurance” and “digital certificates” is clear from this explanation, and accordingly, that the cited references are being misapplied.

In the Final Office dated May 4, 2007, the Examiner also states that “there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.” Applicant notes, however, that modifications to the cited references cannot be a complete redefinition of well-understood terminology.

For at least the foregoing reasons, the Examiner has failed to establish that independent claim 1 is obvious in view of the cited references.

Dependent Claims 2-4, and 11-13

Claims 2-4, and 11-13 depend from claim 1, which is believed to be allowable. Therefore, claims 2-4, and 11-13 are also believed to be allowable for at least the same reasons as claim 1.

Independent Claim 6

Claim 6 recites “comparing the insurance record for the insured to the user-specified insurance requirement of the certificate holder.” The cited references fail to teach or suggest at least these recitations as discussed in more detail above for claim 1. For at least the foregoing reasons, the Examiner has failed to establish that independent claim 6 is obvious in view of the cited references.

Dependent Claims 7-9 and 14

Claims 7-9 and 14 depend from claim 6, which is believed to be allowable. Therefore, claims 7-9 and 14 are also believed to be allowable for at least the same reasons as claim 6.

Independent Claim 15

Claim 15 recites “proof of insurance” and “certificate holder.” The cited references fail to teach or suggest at least these recitations as discussed in more detail above for claim 1. For at least the foregoing reasons, the Examiner has failed to establish that independent claim 15 is obvious in view of the cited references.

Dependent Claims 16-22

Claims 16-22 depend from claim 15, which is believed to be allowable. Therefore, claims 16-22 are also believed to be allowable for at least the same reasons as claim 15.

Conclusion

For the reasons provided herein, Appellant respectfully requests the Board to rule that the rejections of the claims are improper.

Respectfully Submitted,



Dated: 9-22-2007

By: _____

Mark D. Trenner

Reg. No. 43,961

(720) 221-3708

VIII. CLAIMS APPENDIX

1. A computer-implemented method for providing insurance information across a network, comprising:

receiving an access code from a user via the network;

receiving a password from a user via the network;

executing computer-implemented instructions for determining a user class of the user from the access code and password, the user class being one of an agent or a certificate holder;

in the event that the user is an agent, permitting the agent to enter insurance information including a certificate of insurance for an insured;

storing the insurance information along with the date and time of entry as a record in a database;

executing computer-implemented instructions for generating an access code and password corresponding to the insured;

in the event that the user is a certificate holder, permitting the certificate holder to view insurance information for the insured corresponding to the insured's access code and password;

receiving a set of insurance requirements from the certificate holder via the network;

executing computer-implemented instructions for comparing the set of insurance requirements from the certificate holder to the insurance information for the insured to determine if the insurance information complies with the set of insurance requirements; and

executing computer-implemented instructions for displaying an exception report to the certificate holder if the insurance information fails to comply with any of the set of insurance requirements, the exception report indicating which of the insured's insurance information violated the set of insurance requirements.

2. The method of claim 1, wherein a certificate holder may enter a plurality of access codes and passwords via the network, each of the plurality of access codes and passwords corresponding to a single insured of a plurality of insureds.

3. The method of claim 2, further comprising:
permitting the certificate holder to view insurance information for each of the plurality of insureds simultaneously via the network; and
displaying a compliance report to the certificate holder, the compliance report indicating which of each of the plurality of insureds' insurance information violates the set of insurance requirements.

4. The method of claim 3, wherein the compliance report is presented as a table, the table having one row corresponding to each of the plurality of insureds and one column corresponding to each requirement of the set of insurance requirements.

5. (canceled)

6. A computer-implemented method for retrieving and evaluating insurance information across a network, comprising:

inputting at a computer in the network an access code and password for at least one insured;

receiving via the network at least one insurance record comprised of at least one category of insurance coverage for the at least one insured;

inputting at a computer in the network at least one user-specified insurance requirement of a certificate holder who is not the insurance agent;

executing computer-implemented instructions for comparing the insurance record for the insured to the user-specified insurance requirement of the certificate holder to determine if the insurance information complies with the user-specified requirement; and

displaying the results of the comparison.

7. The method of claim 6, wherein the computer-implemented instructions for comparing the insurance record to the user-specified insurance requirement comprises computer-implemented instructions for:

determining whether the user has specified a coverage minimum for at least one insurance category;

determining from the at least one category of insurance coverage comprising the at least one insurance record whether the at least one insured's coverage meets or exceeds the coverage minimum;

creating a table, the table comprised of at least one row corresponding to each of the at least one insured and at least one column corresponding to each of the at least one categories of insurance coverage, the intersection of the at least one row and at least one column forming at least one cell; and

placing in the at least one cell an indicator corresponding to the results of determining whether the at least one insured's coverage meets or exceeds the coverage minimum.

8. The method of claim 7, wherein the indicator further indicates whether the at least one insured's coverage is cancelled or expired.

9. The method of claim 8, wherein the indicator indicating that the at least one insured's coverage is expired is the date of expiration.

10. (canceled)

11. The method of claim 1, further comprising executing a division function for limiting the contents of the exception report.

12. The method of claim 11, wherein the division function includes at least one of the following categories: subsidiary, division, region, branch office, project, territory location, or product.

13. The method of claim 1, wherein the set of insurance requirements received from the certificate holder are minimum insurance requirements the certificate holder requires of the insured.

14. The method of claim 6, further comprising providing the certificate holder with a compliance report for at least one of a plurality of requirement sets.

15. A system of providing proof of an insured's insurance via a network, comprising:

at least one computer-readable medium;

computer-implemented instructions provided on the at least one computer-readable medium, the computer-implemented instructions for:

receiving insurance information for proof of insurance from an agent for an insured of the agent;

storing the insurance information electronically in a database;

comparing the insurance information to a certificate holder's insurance requirements for the insured to determine whether the insured complies with the certificate holder's insurance requirements; and

providing the insurance information as proof of insurance from the database over a network to the certificate holder who is not the agent, the proof of insurance indicating whether the insured complies with the certificate holder's insurance requirements.

16. The system of claim 15, further comprising computer-implemented instructions for generating a compliance report summarizing the compliance status of each coverage for all insureds.

17. The system of claim 15, wherein providing the insurance information to the certificate holder is for each insured for whom the certificate holder has an access code and password.

18. The system of claim 15, further comprising computer-implemented instructions for issuing electronic notices to the certificate holder.

19. The system of claim 15, further comprising computer-implemented instructions for indicating whether the at least one insured's coverage is cancelled or expired.

20. The system of claim 15, further comprising computer-implemented instructions for providing a certificate holder with internet access to the insurance information from a centralized certificate storage repository.

21. The system of claim 15, further comprising computer-implemented instructions for comparing certificates to a certificate holders custom requirements.

22. The system of claim 15, further comprising computer-implemented instructions for validating insurance ratings by at least one independent rating organization.

IX. EVIDENCE APPENDIX

Not applicable.

X. RELATED PROCEEDINGS APPENDIX

Not applicable.